

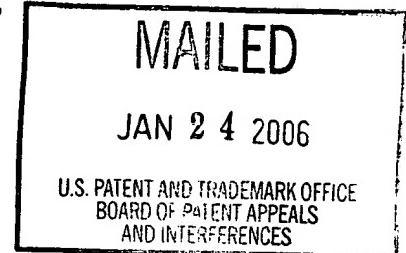
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte C. ALEXANDER TURNER, JR.,
GREGORY DONOHO, XIAOMING WANG,
ERIN HILBUN, BRIAN ZAMBROWICZ,
and ARTHUR T. SANDS

Appeal No. 2005-2379
Application No. 09/689,911



ON BRIEF

Before SCHEINER, ADAMS, and GRIMES, Administrative Patent Judges.¹

GRIMES, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of the decision entered November 30, 2005. That decision affirmed the rejection of claims 1-8, all of the claims pending, for lack of patentable utility. Appellants assert that the previous decision erred in not considering the evidence presented in the Ohtaki references. We have considered Appellants' argument but do not find it persuasive.

¹ The merits panel that issued the initial opinion in this case included Administrative Patent Judge William F. Smith, who retired from the U.S. Patent and Trademark Office before Appellants filed their Request for Rehearing. Administrative Patent Judge Scheiner has replaced Administrative Patent Judge Smith on this merits panel. See In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

In our previous decision, we noted Appellants' reliance on "a journal article by Ohtaki et al. (J. Biol. Chem. 274:37401-37405, 1999)." Decision mailed Nov. 30, 2005, page 5 (citing Appeal Brief, pages 4-5). We concluded that "Appellants' reliance on the Ohtaki reference is misplaced, because the reference was published after the effective filing date of the instant application. . . . Appellants have presented no evidence to show that Ohtaki represents the state of the art as of this application's effective filing date."

Id., page 6.

In their Request for Rehearing, Appellants argue that they

pointed out [in response to an earlier order under 37 CFR § 41.50(d)] that in the first Official Action . . . , the Examiner made two references of record in the present case . . . : 1) Ohtaki et al. (J. Biol. Chem. 274:37041-37045, 1999; "Ohtaki"); and 2) Ohtaki et al., PCT Patent Application Publication Number WO 99/48920 ("WO 99/48920"). Appellants respectfully pointed out that WO 99/48920 was published in Japanese, so merely for the convenience of the Board Appellants focused their arguments on Ohtaki, which was published in English, instead of WO 99/48920.

Request for Rehearing, page 2. Appellants go on to argue that the WO 99/48920 application provides support for their argument that the claimed sequence is similar to known galanin proteins. See id., pages 2-3.

We decline to consider the WO 99/48920 application because that reference was not cited or otherwise relied on in the Appeal Brief. According to 37 CFR § 1.192(a), which was in effect when Appellants filed their Appeal Brief, "[t]he brief . . . must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown."

Appellants have established that they knew of the WO 99/48920 application at least as early as the first Office action in this application but they did not cite that

reference in their Appeal Brief, nor have they pointed to any English-language translation that has been made of record. Under the circumstances, we find that Appellants have not shown the “good cause” required by Rule 192(a) to consider authorities not included in the brief.

Under Rule 192(a), Appellants' reliance on WO 99/48920 is improper. Appellants have not shown good cause for us to waive the requirements of Rule 192(a). Therefore, we decline to consider the WO 99/48920 application.

We have reconsidered our previous opinion in light of Appellants' request for rehearing but decline to make any changes in the opinion.

REHEARING DENIED

Toni R. Scheiner
Toni R. Scheiner

Toni R. Scheiner
Administrative Patent Judge

Dodd E. Johnson

**Donald E. Adams
Administrative Patent Judge**

Z. J. Lin

**Eric Grimes
Administrative Patent Judge**

)
)
)
)
)
) BOARD OF PATENT
)
)
) APPEALS AND
)
) INTERFERENCES
)
)
)

Appeal No. 2005-2379
Application No. 09/689,911

Page 4

Lexicon Genetics Incorporated
8800 Technology Forest Place
The Woodlands, TX 77381-1160